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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/098,204	06/16/98	UDELL H	200.1099

023280 TM02/0417
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EXAMINER	
VU, T	
ART UNIT	**PAPER NUMBER**
2152	13

DATE MAILED: 04/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/098,204	Udell et al
Examiner	**Group Art Unit**
Thong Vu	2152

☒ Responsive to communication(s) filed on *Feb 13, 2001*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-10, 13-15, and 17-47* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-10, 13-15, and 17-47* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

1. This office action is in response to Amendment filed on 2/13/2001. Amended claims 1,6,14, 17-19, new claims 45-47 and original claims 2-5,7-10,13,15,20-43 are pending. Claims 11,12 and 16 are canceled. The rejections cited are as stated below

2. The applicant arguments filed on 02/13/2001 have been fully considered but they are moot in view of the new ground(s) of rejection.

3. Claims 1-10-13-15,17-47 are rejected under 35 U.S.C. § 103 as being unpatentable over Thorne et al [Thorne 5,958,005] in view of Beck et al [Beck 5,903,723]

As per claim 1, Thorne discloses a method for creating a self-destructing document, comprising the steps of creating an executable module which instructs a computer to automatically delete the document to which the executable module is attached when the document, based on a preselected expiration date is expired; attaching the executable module to the document [such as an Email software with the security options including a notice indicating an impending software will be self-destructed, the capability of sender to control the ability of recipient to copy, forward, print and store document, user selects the class of security which it is desired to impose by attach to the document, Thorne col 1 lines 42-col 2 line 55, col 6 lines 22-67, col 7 lines 1-42, col 8 lines 27-42]. Therefore Thorne provides all means necessary to a skilled in the art to create an Email

Thorne also teaches the Private message with the security features such as automatically deleted document after being accessed by the recipient or after a giving time limit or other predetermined events (print, forward, copy, store), notified and user given a warning and option when attempt to process the message as a design choice [Thorne col 8 lines 59-67, col 10 lines 1-62, col 11 lines 5-53, col 12 lines 10-16]. However Thorne fails to explicitly tech the executable

code is attached to the email (or document). Beck discloses a Email message with attachment, and encryption and decryption keys, automatically deleted by a time limit [Beck col 7 lines 1-18]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the email with attachment taught by Beck with Thorne's system. By doing so it would improve the security and reliability on the data processing network.

4. As per claims 2-4, Thorne-Beck disclose the executable module is an executable code, program, macro as program software including Email application [Thorne col 6 lines 22-30]

5. As per claim 5, Thorne-Beck disclose the step of executing the executable module when the document is opened as a design choice of program software [Thorne col 1 lines 42-57, col 6 lines 22-67]

6. Claims 6-10,13-15,17-47 contain the same limitations that were addressed in rejecting claims 1-5 above. By the same rationale applied above, claims 6-10,13-15,17-47 are rejected.

7. Claims 1-10,13-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Ji et al [Ji 5,889,943] in view of MacPhail [4,899,299]

8. As per claim 1, Ji discloses a method for creating a self-destructing document, comprising the steps of creating an executable module which instructs a computer to automatically delete the document to which the executable module is attached, (when the document based on a preselected expiration date is expired); attaching the executable module to the document [Ji abstract col 3 line 55-col 4 line 16, col 18 lines 32-54, col 20 lines 30-40]

However Ji fails to detail when the document based on a preselected expiration date is expired. MacPhail discloses a electronic documents is set for automatically delete by an expiration

data [MacPhail abstract, col 2 lines 48-59]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the message automatically deleted based on an expiration date as taught by MacPhail into Ji's system in order to utilize the email message attach by an executable code would automatically delete by an expiration date. By doing so it would improved the reliability of data storage on the network.

9. As per claims 2-4, Ji-MacPhail disclose the executable module is an executable code, program, macro as inherent feature of program code [Ji line col 1 line 62-col 2 line 9]

10. As per claim 5, Ji-MacPhail disclose the step of executing the executable module when the document is opened [Ji line col 1 line 62-col 2 line 9]

11. Claims 6-10,13-15 contain the same limitations that were addressed in rejecting claims 1-5 above. By the same rationale applied above, claims 6-10,13-15,17-47 are rejected.

12. Claims 17-47 are rejected under 35 U.S.C. § 103 as being unpatentable over Ji et al [Ji 5,889,943] in view of MacPhail [4,899,299] and further in view of Shear [5,410,598]

As per claim 17, Ji-MacPhail disclose a self-destructing email messaging system comprising an executable module, the executable module configured to instruct a computer to automatically delete an email message to which the executable module is attached when a predetermined condition is met ; an email messaging system, the email messaging system configured to create the message and to transmit the message, the email messaging system attaching the executable module to the message prior to transmission [Ji abstract col 3 line 55-col 4 line 16, col 18 lines 32-54, col 20 lines 30-40][MacPhail abstract, col 2 lines 48-59]

However Ji-MacPhail fail to teach said predetermined condition is selected from the group consisting of an attempt to print, copy, forward the message. Shear taught this well-known

technique in the network security art such as a security database system with the encryption and decryption data including the self-destruction option when user attempt to access an unauthorized feature [Shear abstract, col 18 line 55-col 19 line 19]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the message automatically deleted based on an attempt to access an unauthorized feature as taught by Shear into Ji-MacPhail system in order to prevent the unauthorized data processing on the network.

13. Claims 18-47 contain the similar limitations that were addressed in rejecting claims 1-17 above. By the same rationale applied above, claims 18-47 are rejected.

14. Claims 1-10,13-15,17-47 are rejected under 35 U.S.C. § 103 as being unpatentable over Hansen [Enhancing documents with embedded programs: How Ness extends insets in the Andrew Toolkit] in view of Beck et al [Beck 5,903,723]

As per claim 1, Hansen discloses a method for creating a self-destructing document, comprising the steps of creating an executable module which instructs a computer to automatically delete the document to which the executable module is attached when the document, based on a preselected expiration date is expired; attaching the executable module to the document [Hansen, page 28 col 2 lines 4-13]

However Hansen fails to detail the a preselected expiration date is expired. Beck discloses a Email message with attachment automatically deleted by a time limit and encryption and decryption keys [Beck col 7 lines 1-18]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the technique of a email message automatically deleted by an expiration date as taught by Beck and Hansen's system. By

doing so it would improve the security and reliability for message storage and transaction between client/server.

15. As per claims 2-4, Hansen-Beck disclose the executable module is an executable code, program, macro as inherent feature of software code [Hansen page 28 col 2 lines 4-13]

16. As per claim 5, Hansen-Beck disclose the step of executing the executable module when the document is opened [Hansen page 28 col 2 lines 4-13]

17. Claims 6-10,13-15,17-47 contain the same limitations that were addressed in rejecting claims 1-5 above. Examiner would take an Official Notice, that the technique self-destruction of data, message, software will be activated whenever user attempt to access an unauthorized feature is well-known in the network security art [see Shear, Thorne references]. By the same rationale applied above, claims 6-10,13-15,17-47 are rejected.

18. Claims 1-10,13-15,17-47 are rejected under 35 U.S.C. § 103 as being unpatentable over Drake [6,006,328] in view of Norin et al [Beck 5,787,247]

As per claim 1, Drake discloses a method for creating a self-destructing document, comprising the steps of creating an executable module which instructs a computer to automatically delete the document to which the executable module is attached when the document, based on a preselected expiration date is expired; attaching the executable module to the document [such as a message with a header is attached by a executable code or software which is designed to self-destruct, Drake Fig 10, col 7 lines 43-52]

However Drake fails to detail the a preselected expiration date is expired. Norin discloses a Email message with time-based expiration date wherein an object is older a set time will be

deleted automatically [Norin col 24 lines 1-25]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the technique of a email message automatically delete by an expiration date as taught by Norin and Drake's system. By doing so it would improve the reliability for data storage and transaction between client/server.

19. As per claims 2-4, Drake-Norin disclose the executable module is an executable code, program, macro as inherent feature of software code [Drake Fig 10, col 7 lines 43-52]

20. As per claim 5, Drake-Norin disclose the step of executing the executable module when the document is opened [Drake Fig 10, col 7 lines 43-52]

21. Claims 6-10,13-15,17-47 contain the same limitations that were addressed in rejecting claims 1-5 above. Examiner would take an Official Notice, that the technique self-destruction of data, message, software will be activated whenever user attempt to access an unauthorized feature is well-known in the network security art [see Shear, Thorne references]. By the same rationale applied above, claims 6-10,13-15,17-47 are rejected.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Mark Rinehart*, can be reached at (703) 305-4815.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks

Washington, D.C. 20231

or faxed to :

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-7201 (for informal or draft communications, please label "PROPOSAL" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Thong Vu

Apri 15, 2001

MEHMET B. GECKIL
PRIMARY EXAMINER